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## REMARKS

The Examiner has rejected Claims 1-4, and 6-8 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,398,196 to Chambers in view of International Application Publication WO-93/25024 (PCT/US93/05029) to Branham in view of applicant's admitted prior art (AAPA).

In response to applicant's previous amendments and remarks, the Examiner argues that "Branham teaches at least the new limitations of the amended claims." Applicant respectfully disagrees with such assertion.

Specifically, the Examiner relies on page 6, line 16 through page 7, line 15; page 8, line 4 through page 8, line 27; page 3, lines 15-26; and page 5, lines 20-32 to make a prior art showing of applicant's claimed "determining in response to and after a closure request, but before file closure, if the opened computer file has been modified since being opened" (see this and similar limitations in each of the independent claims).

Branham, however, merely suggests various security techniques that are initiated as a function of a file being modified. There is simply no disclosure, teaching or suggestion of making a determination as to whether a file is modified relative to the open and closure thereof, as claimed. Specifically, Branham is completely devoid of any sort of "determining in response to and after a closure request, but before file closure, if the opened computer file has been modified since being opened" (emphasis added).

Only applicant teaches and claims such feature which enables the presently claimed invention to minimize the scanning of an opened filed for viruses between a time a user requests closure of the file, and the time the file is actually closed. A notice of allowance or a specific prior art showing of the foregoing claim limitations, in combination with the remaining limitations, is respectfully requested.

It appears that the Examiner continues to rely on applicant's admitted prior art (AAPA) to make a prior art showing of applicant's claimed "scanning said opened file for viruses before

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closure only if said opened file has been modified" (see this and similar limitations in each of the independent claims). Specifically, the Examiner argues that AAPA "discloses that an opened file is scanned before closure."

In response, applicant notes that, even if the Examiner's assertion is correct, AAPA still does not provide for a technique for "scanning said opened file for viruses before closure <u>only if said opened file has been modified</u>" (emphasis added). Again, such feature is paramount for minimizing the scanning of an opened filed for viruses between a time a user requests closure of the file, and the time the file is actually closed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has simply not been met, <u>since the prior art references, when combined, fail to teach or suggest all the claim limitations</u>.

It is further noted that the Examiner's application of the prior art to applicant's dependent claims is similarly replete with deficiencies. Just by way of example, the Examiner has rejected Claims 2-3 by relying on col. 3, line 64 -- col. 4, line 3; col. 10, lines 7-14; and col. 9, 11-60.

After careful review of such excerpts, however, applicant asserts that there is simply no suggestion of a "dirty cache buffer," let alone:

"<u>before</u> said detecting step, the steps of:
      <u>determining whether said operating system includes a "dirty cache buffer" to</u>

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raise or set a modification flag relative to a file being modified during the time it has been open, a computer code being indicative of said flag; and

using the computer code for a raised or set modification flag, if available, for carrying out said modification determining step by checking for the presence of a raised modification for said file" (see Claim 2 – emphasis added); and

"wherein if it is determined that said operating system does not provide a file modification flag, said method further includes the steps of:

establishing a "dirty cache buffer"; and

raising a modification flag in said "dirty cache buffer" if an opened file associated with said flag has been modified by a write operation" (see Claim 3 – emphasis added).

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has simply not been met, since the prior art references, when combined, fail to teach or suggest all the claim limitations. A notice of allowance or a specific prior art showing of each of the claim limitations noted above, arranged as required by the claims, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P194/99.115.01).

Respectfully submitted,

By: _____          Date: _____6/18/04_____

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